

Application No. 09/743,649

RCA 88,650

REMARKS

Claims 1 - 11 are pending in this application.

Rejection of Claims 1-11 under 35 USC § 103(a)

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers et al. (U.S. Patent No. 5,063,547) in view of Bcst (U.S. Patent No. 4,569,026) in further view of Ito et al. (U.S. Patent No. 5,499,221) in further view of Fujita et al (U.S. Patent No. 5,974,219). Applicants respectfully traverse the rejections.

The present claimed invention provides a method and apparatus for controlling a system for processing stored information on a storage medium. Stored information is played back during a play mode of operation and the user is provided an opportunity to select a bookmark representing a corresponding location at any point within the stored information from among a plurality of bookmarks responsive to the user's input during play mode. The stored information is played back from the location corresponding to the selected bookmark during the play mode of operation. An on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium is generated. The user is allowed to perform one of setting a new bookmark; selecting a bookmark and clearing the selected bookmark; selecting the bookmark and playing back the stored information from the location corresponding to the selected bookmark; and undoing a previously performed operation while continuing to watch program information playback in a background portion of the video display. In response to a user selecting a bookmark, the playback circuitry retrieves information from the storage medium starting at the location corresponding to the selected one of a plurality of bookmarks during the play mode of operation. This eliminates the need to press fast-forward to scroll to the user's desired point in the video. Independent claims 1 and 11 contain features similar to those discussed above and thus all arguments presented below apply to both claims.

Application No. 09/743,649

RCA 88,650

Custers et al. describe a Compact-Disc Digital Audio player in which different users, independently of one another, can store preferred selections of specific discs in a memory. The player identifies the discs from the sub-code on the disc. The user identification can be entered in the player. The user identification and the record carrier identification are combined to form one identification code. The player also detects whether a preferred selection program is stored in the memory associated with the identification code. If an identification code is stored, the player reproduces the relevant information from the disc in the sequence specified by the preferred-selection program.

The Examiner contends that Custers discloses a method and apparatus of controlling a system for processing stored information on a storage medium similarly to the present invention. Applicants respectfully disagree. Although Custers describes a Compact-Disc Digital Audio player that can store a preferred selection of specific discs in a memory, Custers neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in the present claimed invention. Conventional media disc menus are configured such that the user can begin playback from the starting point of a selected video title or chapter. The menus, however, do not allow the user to select an arbitrary point within a video title or chapter for starting playback. However, the present claimed invention allows the user to set bookmarks "representing a corresponding location at any point within the stored information" as recited in the present claimed invention. By providing for bookmarks to be set at any point within the stored information, the present claimed invention provides users with the convenience of jumping to a pre-selected location within a video title or chapter in response to user input without having to manipulate the various transport keys in order to locate and start the playback.

In column 3, lines 7-10, Custers states that "The player has the possibility of storing preferred program selections of a plurality of discs in a memory, identifying,

Application No. 09/743,649 RCA 88,650
discs to be played and, if desired, playing the preferred program selection.” While the “preferred program selection” in Custers may represent bookmarks of specific tracks on discs, these “preferred program selection” in Custers, however, neither disclose nor suggest bookmarks “representing a corresponding location at any point within the stored information”, as recited in the present claimed invention.

Additionally, as admitted in the Office Action, Custers neither discloses nor suggests “providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; a menu allowing the user to perform one of the following: set a new bookmark, selecting a bookmark and clearing the selected bookmark, selecting a bookmark and play back the stored information from the location corresponding to the selected bookmark, and undo a previously performed operation while continuing to watch the program information playback in a background portion of the video display; providing the user the opportunity to select a bookmark, representing a corresponding location at any point within the stored information”.

Best describes a video entertainment system by which human viewers conduct simulated voice conversation with screen actors or cartoon characters in a branching story game shown on a television screen. Different audio and video frames are generated from a videodisc and data memory to provide one of several alternative replies or alternative actions at each branch point in the game, depending on what the viewer says to a speech-recognition unit. Best, similar to Custers, neither discloses or suggests “providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input” and “changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation” as recited in the present claimed invention. Best allows the user to interact with the video entertainment system via voice commands. In Best, points in the game are represented by special story commands which can point to several subsequent chains of story commands.

Application No. 09/743,649

RCA 88,650

These chains of commands, however, do not allow the user to "set a new bookmark", nor does it allow the user the ability to "select a bookmark and clearing the selected bookmark" as recited in independent claims 1 and 11 of the present invention. The prompted commands are predetermined by the game system, not the user.

Ito et al. describe a portable CD-ROM retrieval apparatus. A CD-ROM drive loads a CD medium. A color liquid crystal display shows characters and images and similar information output of the CD-ROM drive and showing a menu. A joystick directing device selects a desired menu item. An audio output circuit outputs audio information such as music or voice. These components are integrated in a single unit. The Office Action asserts that Ito discloses a CD-ROM retrieval apparatus which retrieves position wherein the user has left a bookmark at any position on the recording medium. Applicants respectfully disagree. While Ito can store position information such as last read page and line, and "automatically retrieves the position which is to start reading" (Ito, column 12, lines 29-31), the apparatus does not actually store bookmarks in response to user input. Thus Ito, similarly to Custers and Best, neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in the present claimed invention.

Fujita et al. describe a control method for detecting change points in motion picture images to extract desired video cut during a single playing operation of the video image, and the video image can be edited in a high efficiency. When a user designates a frame of a video image under playing operation, a detection made of a change point in the video cut containing this designated frame in both forward and reverse playing direction. Fujita, similar to Custer, Best, and Ito, neither discloses nor suggests "select[ing] a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user inputs" and "changing to playing back the stored information from the location

Application No. 09/743,649 RCA 88,650
 corresponding to the selected bookmark during the play mode of operation". While Fujita allows a user to designate a frame of a video image under playing operation and "automatically detecting a change point of a video cut based upon a feature amount of the digital signal with respect to each of the frames of the video image" (column 4, lines 59-61), the method does not change playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation. In fact, Fujita merely describes a method for allowing a user to designate a frame for the purpose of editing image data and is not concerned with setting a bookmark for playing back the stored information from the location corresponding to the bookmark. Thus, Fujita describes a fundamentally different method than the present claimed invention and fails to disclose or suggest a selected bookmark and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as in the present claimed invention.

Applicants respectfully submit that there is no motivation or reason to combine Custers, Best, Ito and Fujita. Best, contrary to Custers, Ito and Fujita, provides an interactive video entertainment system that responds to voice commands to play the appropriate programs in response to the commands. Best combines an apparatus for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands. Custers provides for users to make selections to be stored in memory prior to playback while the Best system requires that the user, in an interactive video entertainment environment, make a selection while a media disc is being played. Ito provides a CD-ROM retrieval apparatus. Ito does not provide storage of user preferences. Fujita, contrary to Custers, Best, and Ito, provides a method for editing frames of image data by detecting change point in the image data. Fujita allows a user to pick a frame for the purpose of editing while Custers provides for users to make track selections for playback. These references are responsive to different problems and thus it is respectfully submitted that the combination of these references to produce the present claimed invention would not be obvious. Custers involves making "selection of preferred programs...rapid and reliable" (column 2, lines 8-11) while Best provides an interactive video game which creates "illusion of individualized and active

Application No. 09/743,649

RCA 88,650

participation in a two-way conversation" (column 2, lines 4-7). On the other hand, Ito involves making a more effective CD-ROM retrieval system (column 2, lines 13-18) while Fujita provides a method of editing image data in a high efficiency (column 6, lines 3-14). Thus, the combination of the systems of Custers, Best, Ito and Fujita would provide for a CD-ROM retrieval system that requires a user to predetermine a sequence for playback while also requiring a user to make a selection during playback of a media disc and automatically detecting user selection for the purpose of editing image data. Consequently, it is respectfully submitted that the operation of the systems of Custers, Best, Ito and Fujita are conflicting and thus there is no motivation or reason to combine Custers, Best, Ito and Fujita and even if combined, the combination does not yield the present invention.

However, even if one were to combine the four systems, the combination would produce a CD-ROM retrieval digital audio player for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands and that can store preferred selections of specific discs in a memory and edit user-selected frames of image data. This combination would still not allow a user to retrieve a bookmark representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input and change playback of the stored information from the location corresponding to the selected bookmark during the play mode of operation. Therefore, similar to the individual systems, the combination of the systems of Custers, Best, Ito and Fujita neither disclose nor suggest retrieving bookmarks "representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in the present claimed invention.

Furthermore, the combination of each reference must provide the invention as claimed, without the benefit of hindsight provided by the application. The present claimed invention provides a user an opportunity to select a bookmark representing a corresponding location at any point within stored information from among a plurality

Application No. 09/743,649 RCA 88,650
of bookmarks responsive to user input and the stored information is played back from the location corresponding to the selected bookmark during the play mode of operation. Thus, a user will be able to select arbitrary point within the stored information without the need to press fast-forward to scroll to the user's desired point in the video. These functions are not disclosed in any of the cited references. It is thus respectfully submitted that the arguments of obviousness of the Office Action are based upon picking selected passages from each of the cited references based on knowledge obtained from the present application and therefore are based on impermissible hindsight.

In view of the above remarks it is respectfully submitted that Custers, Best, Ito and Fujita, when taken alone or in combination, do not make the present invention as claimed in Claims 1 and 11 unpatentable. As Claims 2-10 are dependent on Claim 1, it is respectfully submitted that these claims are also allowable for the same reasons discussed above. It is thus further respectfully submitted that these rejections are satisfied and should be withdrawn.

Having fully addressed the Examiner's rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Application No. 09/743,649

RCA 88,650

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account 50-2828.

Respectfully submitted,
Debbie Indira Lewis et al.

By: 

Jack Schwartz

Reg. No. 34,721

Tel. No. (212) 971-0416

Thomson Licensing Inc.
Patent Operations
PO Box 5312
Princeton, NJ 08543-5312
July 13, 2006